

REMARKS

Entry of this Amendment is proper under 37 CFR §1.116, since no new issues are presented and the claim amendments and arguments presented herein reduce the issues for appeal by clarifying the significance of a key feature of the present invention that the Examiner seems to fail to recognize and by explaining why the Examiner's rationale for maintaining the rejection under 35 USC § 112, first paragraph, is incorrect. It is also noted that, as explained below, prior to appeal, the Examiner needs to justify on the record that the motivation to modify the primary reference Muhme is a reasonably proper motivation, rather than a mere conclusory statement.

Claims 1-2, 4-6, 8-16, and 18-29 are all the claims presently pending in the application. New claims 28 and 29 are added to merely re-instate the alarm limitation as being separate dependent claims (previously canceled), rather than elements necessary in the independent claims to differentiate from Muhme.

It is noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1, 2, 4-6, 8-16, and 18-26 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 4-7, 9-15, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme (U.S. Patent No. 5,886,634), further in view of Yeadon (U.S. Patent No. 6,393,339).

Claims 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 4,881,061 to Chambers.

Claims 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 5,883,582 to Bowers et al.

Claims 2 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, further in view of U.S. Patent No. 5,984,388 to Bacon.

Claims 8 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 6,297,727 to Nelson.

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Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon and Nelson, and further in view of US Patent 5,745,036 to Clare.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

Applicant's invention, as defined, for example, in a non-limiting embodiment of independent claim 1 (and substantially similarly by independent claims 15 and 21) is directed to a system (and method) system for preventing theft of an object. An electronic article surveillance (EAS) device operatively attached to an object, and there is a security path for detection of the EAS device.

A reader is operatively coupled to the security path. The reader is intended to read a smart card containing an identification profile of an authorized user of the object. A computer is attached to the reader and disables the security gate if a person entering the security path is authorized to remove the object.

With such features, an authorized person exhibiting a smart card does not trigger the alarm or is allowed free passage with the tagged object. Or, in an exemplary sales environment, if a retail clerk forgets to remove the EAS device after a legitimate sale, the present invention allows an authorized user, such as a security guard standing near the exit, to reset the alarm by presenting a smart card to the smart card reader located nearby, thereby allowing the alarm to be reset without having to leave the exit area to reset the alarm.

Therefore, the present invention allows a secure method to easily reset a detected security breach that has been activated due to an error. That is, although the card reader might be readily accessible, only a holder of a smart card will be able to reset the system upon activation due to an error. Further, fast reliable tracking of personnel carrying objects (e.g., such as personal computers) into/or of an area can be achieved.

The conventional systems, such as those discussed below and in the Related Art section of the present application, do not have such a structure, and fail to provide for such an operation (e.g., see page 6, lines 18-22 and page 7, lines 1-7 of the present application).

Such features are not taught or suggested by any of the cited references. That is, the present invention includes a new combination of elements such that both a tag and a smart card are uniquely combined to provide features that are not available in the prior art of record, even if the prior art references were properly combinable.

That is, Applicants submit that the present invention is indeed a new combination of elements, even if these elements can be found in isolation in the prior art in combinations that differ from that of the present invention.

II. THE REJECTION UNDER 35 USC §112, FIRST PARAGRAPH

Claims 1, 2, 4-6, 8-16, and 18-26 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. As best understood, the Examiner considers that it is disclosed at lines 18-22 of page 6 and lines 1-4 of page 7 that the tag, rather than the computer, that controls the alarm.

Although Applicants have eliminated this disputed feature from the independent claims for another reason, Applicants respectfully disagree with the position understood to have been adopted by the Examiner that the tag is the actuator that turns the alarm off, rather than the computer. The description at lines 1-4 very clearly state that it is the "invention" that turns the alarm off.

Applicants submit that one of ordinary skill in the art would clearly understand this description as meaning that the alarm is turned off after an authorized user presents a smart card to the reader. Since the reader is connected to the computer, which determines whether the input represents an authorized user, it is indeed appropriate to describe that the computer then sends a signal to turn off the alarm.

That is, even though it is reasonable to assert that the tag is responsible for turning on the alarm, it is not reasonable to assert that it is the tag that also turns the alarm off, as the Examiner seems to allege.

Accordingly, Applicants request that the Examiner reconsider and withdraw this rejection.

III. THE PRIOR ART REJECTIONS

The Examiner alleges that Muhme teaches all elements of claim 1 but concedes that Muhme fails to teach or suggest the use of a smart card.

To begin with, it is pointed out that the rejection currently of record fails to meet the initial burden of a *prima facie* rejection, as clearly stated by the evaluation guidelines in the MPEP.

First, it is pointed out that MPEP §2141.02 clearly states the following very basic evaluation guideline: "*In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious*" (emphasis in MPEP itself).

This guideline reflects the well established concept in patentability evaluation that a new invention may "merely" be a new and different combination of known elements.

Second, it is pointed out that MPEP §2143.01 clearly states a second guideline: "*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination*" (emphasis in MPEP itself).

Along these lines, Judge Rader wrote in the recent Federal Circuit Court of Appeals holding in *Ruiz v. A.B. Chance Co.*, Federal Cir., No. 03-1333, January 29, 2004:

"In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention."

Although the holding in that case left undisturbed, under the "clear error" standard of review, the conclusion of the District Court that the prior art references were properly

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combinable, it specifically explained that it declined to reverse this conclusion because "... the two references address precisely the same problem ..." (emphasis by Applicants)

This aspect of the *Ruiz* holding, in which precisely the same problem is being addressed by both references, is not present in the Muhme and Yeadon references used in the prior art evaluation of the present Application. That is, in Muhme, the problem addressed is that of preventing an unauthorized user from removing an item through a security path.

In Yeadon, in contrast, the problem addressed is that of allowing only authorized users to operate a dispensing apparatus and to determine which items a specific authorized user is allowed to dispense. Applicants submit that these two problems are not only distinctly different but that one of ordinary skill in the art would not even be inclined to modify Muhme to incorporate smart cards rather than tags, as explained in greater detail below.

Third, it is pointed out that MPEP §2143.01 clearly states a third guideline:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."

Therefore, given the above guidelines, Applicants respectfully submit that the rejections currently of record fail to meet the initial burden of a *prima facie* rejection, for the following reasons.

First, the Examiner correctly concedes that Muhme fails to reasonably teach or suggest using a smart card. However, Applicants submit that Muhme more than merely fails to suggest the use of a smart card. Applicants submit that this reference clearly teaches against a modification to use a smart card and that one of ordinary skill in the art would not be inclined to make such modification absent improper hindsight that recognizes an advantage that is not suggested in Muhme.

That is, Muhme clearly teaches an entirely different technique, one in which a self-authorizing tag, rather than a smart card, is used to allow the user to pass through the security path. In line 55 of column 2 and in line 12 of column 3 of Muhme teaches the use of simple "tags" 20, 22, one each on the item 12 and the person 14.

The significance of recognizing this technique in Muhme of using a "self-authorizing tag", rather than a "smart card containing an identification profile of an authorized user", as used

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in the present invention, is, first, there is no need to modify Muhme, since it already incorporates an entirely different technique from that described in the present invention (e.g., a tag is used in Muhme, whereas a smart card is used in the present invention) to disable the security path so that an authorized user can pass through without setting off an alarm or otherwise blocking the security path exit.

That is, the Examiner's motivation that a smart card would "... provide a more secure system" is not credible in view that Muhme already has a "secure system", and there is no justification to define that a technique based on smart cards is any more secure than one based on a self-authorizing tags.

Second, since one of ordinary skill in the art would recognize that the technique already implemented in Muhme, in which the authorized user wears a second tag 22 or, as described at lines 37-52 of column 4, either the container or transportation cart is fitted with a self-authorizing tag, would be much more convenient than using the technique of the present invention in which an authorized user must present a smart card to the reader in order to exit the security path. Thus, Applicants submit that this convenience aspect of the self-authorizing tag of Muhme would clearly teach against a modification to replace self-authorizing tags with smart cards.

Additionally, since adding a reader and smart card into Muhme and deleting the self-authorizing tag that is currently used, the Examiner would be improperly changing the principle of operation of Muhme.

Therefore, Applicants submit that the initial burden of the Examiner is more than merely identifying that Muhme does not use a smart card, but rather, the Examiner must present a reasonable motivation to replace the self-authorizing tags of Muhme with smart cards.

Applicants additionally submit that the rejection currently of record fails to properly provide a realistic motivation to replace the self-authorizing tags used in Muhme with a smart card that is consistent with the above-recited caselaw and MPEP guidelines. The motivation provided in the rejection currently of record is merely a conclusory statement of the Examiner's purported benefit to be achieved if the modification were to be made.

Applicants submit that this motivation is improper circular reasoning in which the motivation to modify or combine a reference is that of obtaining the benefit of having made the combination. Applicants submit that this circular reasoning is exactly what Judge Rader and the

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above-cited MPEP guidelines attempt to prohibit. That is, the circular reasoning exhibited by the current rejection would render everything obvious.

Therefore, Applicants submit that the Muhme and Yeadon references, either alone or in combination, are much different from the present invention and fail to teach or suggest the claimed invention.

Indeed, Applicants submit that, if Muhme were to be combined with Yeadon, the most that could reasonably be asserted is that the resultant combination provides a drug dispensing apparatus, enabled by a smart card, that perhaps shares one or more components with a security system that is based upon a first tag attached to a secured item and a second (self-authorizing) tag that permits the secured item to be removed. Since there is no suggestion in Yeadon to use self-authorizing tags and there is no suggestion in Muhme to use smart cards, the most reasonable shared component becomes the computer than is a component in each.

Simply picking out the card reader in Yeadon, as done in the rejection of record, is exactly what Judge Rader states as being impermissible.

Finally, the Examiner relies upon Chambers as demonstrating that a magnetic strip is a known element in the art, upon Bowers as demonstrating that continuous transmission of a tag is a known element in the art, upon Bacon as demonstrating that an acousto-magnetic tag is a known element in the art, upon Nelson as demonstrating that a video receiver is a known element in the art, and upon Clare as demonstrating that activating a video image after the alarm is turned off is a known element in the art.

Regardless of whether these additional combinations urged by the Examiner are reasonably proper under the above-recited case law and MPEP guidelines, these additional secondary references do not overcome the basic deficiency in the rejection that Muhme cannot be properly combined with Yeadon, since such combination would change the principle of operation of the primary reference Muhme.

Hence, turning to the clear language of the claims, there is no teaching or suggestion in Muhme of "... a reader operatively coupled to said security path; a smart card for being read by said reader, said smart card containing an identification profile of an authorized user of said object; and a computer attached to said reader, said computer disabling said security gate if a person entering said security path is determined as being authorized to remove said object after

having said smart card read by said reader....”, as required by independent claim 1. The remaining independent claims contain similar language.

Applicants additionally comment briefly as to the significance of the alarm reset feature defined in independent claim 21 and removed from independent claims 1 and 15 to be more properly accorded dependent status (e.g., new dependent claims 28 and 29) as a truly distinct invention combination from that defined by claims 1 and 15.

That is, although the Examiner correctly points out that lines 11-14 of column 8 of Muhme describe that the alarm can be reset, there is no suggestion that this alarm reset is accomplished by using a smart card in combination with a smart card reader. The more likely configuration is that a master RESET switch exists in a secured location, such as a security office.

In contrast, the present invention as exemplarily defined by independent claim 21 provides a system in which the alarm RESET function is incorporated as a smart card reader that can be located at or near the exit in the security path. Because the alarm RESET function in this exemplary embodiment is secured by requiring a smart card to be used, the present invention allows a security officer to reset the alarm at the exit gate itself, retaining the same security of the RESET switch that is located in a remote secured location, but without the need to leave the exit to go into a secured area where the RESET switch is located. That is, the present invention allows the alarm RESET “switch” to be both secured and readily accessible at the gate.

Muhme makes no suggestion for this feature uniquely provided by the present invention by its use of smart card instead of the self-authorizing tag used in that reference.

For the reasons stated above, the claimed invention is fully patentable over the cited references.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-2, 4-6, 8-16, and 18-29, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance,

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the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



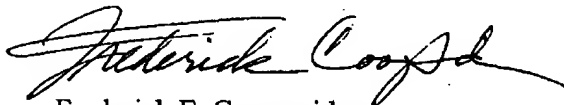
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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9306 this Amendment under 37 CFR §1.116 to Examiner V. Brown on February 23, 2003.



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